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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,737	06/22/1999	YOJI ISHIDA	21.1927/NLO	9339
21171	7590	06/30/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,737

Applicant(s)

ISHIDA ET AL.

Examiner

Nga B. Nguyen

Art Unit

3628

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is the answer to the communication filed on February 3, 2004, which paper has been placed of record in the file.
2. Claims 1-36 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-12, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Grant et al (hereinafter Grant), U.S. Patent No. 5,878,405.

Regarding to claim 1, Grant discloses a computer-based retirement plan comprising:

a menu-based data input interface (figure 3 and column 15, line 45-column 16, line 37);

employee individual account number allocation (figure 5D, item 1920 and column 18, lines 10-12, the liquidity account number);

electronic processing of retirement plan activities (column 20, line 33-column 21, line 63) including at least: electronic production, distribution, and modification of forms accessible via menu based data input interface (column 15, lines 45-62, application on-line form; column 14, lines 47-52 and column 15, lines 20-25, generate reports; column 20, lines 64-67, provide a form to apply to the Social Security Administration);

a tracking function enabling, in conjunction with electronic processing, tracking of electronically processed activities including at least electronically produced forms, distribution, and modification including any associated data input (column 14, lines 47-52; column 15, lines 20-25 and column 16, lines 14-37), the tracking performed to verify compliance with a set of requirements associated with the retirement plan (figure 6C, item 2270, testing whether new rate contribution meet the guidelines; column 10, lines 55-67 and column 18, lines 34-63; verifying the loan limit is not exceed the regulatory limits; column 17, lines 1-15, verifying whether spousal consent forms are required; column 16, lines 19-22, audit reports prepare schedules and samples in support of the requirements designed by the CLMS to satisfy the requirements under SAS #70).

Regarding to claim 2, Grant further discloses retirement plan comprises a 401(k) plan or other government-sanctioned qualified savings plan (column 10, lines 15-27).

Regarding to claim 3, Grant further discloses employees can receive reports based on one or more tracked activities (column 15, lines 20-25).

Regarding to claims 4, 5, Grant further discloses plan may be implemented locally or remotely on one more computer-based systems, across networks or existing communication mediums, across networks element comprises any of LAN, WAN, cellular, Internet or Web based networks (column 14, lines 19-33).

Regarding to claim 6, Grant further discloses tracking function enables auditing of a sequence of individual account activities (column 34, lines 20-30).

Claims 7-12 are written in computer software that parallel limitations as found in claims 1-6 above, therefore are rejected by the same rationale.

Regarding to claim 20, Grant further discloses tracking function additionally enables auditing of fee based transactions (column 20, lines 1-8).

Regarding to claim 21, Grant further discloses tracking of distribution comprises tracking of employee's request and delivery of forms (column 15, lines 20-25, provide account reports as requested by employee).

6. Claims 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoen et al (hereinafter Schoen), U.S. Patent No. 6,235,176.

Regarding to claim 13, Schoen discloses a computer-based retirement plan including: a plurality of employee accounts (figure 18) a plurality of retirement plan activities comprising at least: mutual fund selections and employee choices thereof (figure 29), employer information and reporting comprising:

- a menu-based data input interface (column 15, lines 19-27);

- employer information comprising individual account number allocation per employee for each separate mutual fund selection (figures 16-18 and column 15, lines 35-40, SSN as account number allocation per employee for each separate plan or mutual fund selection);

- electronic tracking of one or more of plurality of retirement plan activities, and wherein electronic tracking ensures compliance of retirement plan requirements associated with *one or more* of the following: activities logged for each account number; reports produced for each individual; direct access provided to mutual fund balances for an individual employee, or new mutual fund added choices for individual employees

(figures 32-36, report produced for John AAron; column 23, lines 23-30, tracking of plan participants' contributions and status; column 26, lines 32-45, producing reports; column 23, line 65-column 24, line 42, adding new plan or mutual fund; column 30, lines 45-55, computing and processing coverage amount for each accounts by using the amounts of contribution in accordance with terms of retirement plan and in compliance with the IRS Code Section 401(a); column 4, lines 55-63, tracking initial and ongoing compliance of the disability coverage under applicable state and federal law).

Regarding to claim 14, Schoen further discloses retirement plan comprises a 401(k) plan or other government-sanctioned qualified savings plan (column 5, lines 14-18).

Regarding to claims 15, 16, Schoen further discloses plan may be implemented locally or remotely on one more computer-based systems, across networks or existing communication mediums, across networks element comprises any of LAN, WAN, cellular, Internet or Web based networks (column 14, lines 1-8, plan implemented locally, across network is LAN).

Regarding to claim 17, Schoen further discloses tracking function enables auditing of a sequence of individual account activities (figures 32-36).

Regarding to claim 18, Schoen further discloses an electronic summary of employee accounts and modifications is automatically generated (figures 37-38 and column 26, lines 32-45).

Regarding to claim 19, Schoen further discloses electronic tracking enables testing for regulatory compliance (column 4, lines 55-63, tracking initial and ongoing compliance of the disability coverage under applicable state and federal law).

Conclusion

7. Claims **1-36** are rejected.

8. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Harris et al. (US 5,918,218) disclose the 401(k) record keeping system performs trade entry, record keeping, reporting, and IRS compliance functions, verifying the transactions are within legal and IRS compliance (see column 6, lines 15-30).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal

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Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen

Nga Nguyen

April 28, 2004